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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,348	09/12/2003	Kim Tempest	19467-00009	6748
22334 7590 01/03/2007 PETER F WEINBERG GIBSON DUNN AND CRUTCHER LLP SUITE 4100 1801 CALIFORNIA STREET DENVER, CO 80202			EXAMINER FERNSTROM, KURT	
			ART UNIT 3711	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/03/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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## Office Action Summary

Application No.

10/661,348

Applicant(s)

TEMPEST ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-20, 22-30, 32-41 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20, 22-30, 32-41 and 49-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-20, 22-30, 32-41 and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannon. Cannon discloses in the specification a gaming apparatus and method comprising a plurality of different games, which operate simultaneously, and where one or more of the games can act as a bonus indicator. Column 8, lines 34-46 discusses the simultaneous play of the games. Column 8, line 66 to column 9, line 20 and column 32, lines 55-60 disclose that different games may be played simultaneously. Column 24, lines 14-61 discusses a bonus which may be indicated by one or more of the games. Claim 93 of Cannon is also directed to a bonus resulting from at least one of the games. Any of the plurality of games played may be designated as a “primary” or “bonus” game, as there is nothing inherent in a primary game or bonus game which is not disclosed by Cannon. Cannon further discloses that the bonus indicator for one game operates independently of other simultaneous games. With respect to claims 2-6, 13-17, 23-27 and 34-38, Cannon discloses in Column 8, line

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66 to column 9, line 11 discloses the specific games recited in the claims, including different types of reel games and roulette games. With respect to claims 7, 8, 18, 19, 28, 29, 39 and 40, Cannon discloses in column 8, lines 24-29 that the gaming apparatus is linked to a casino management system and to other gaming machines. With respect to claims 9, 20, 30 and 41, Cannon discloses in column 15, lines 14-28 and column 19, lines 52-55 that the gaming apparatus includes a bonus indicator which shows participation in a tournament among linked machines. With respect to claims 11, 12, 32 and 33, Cannon discloses in column 24, line 32 and column 28, line 10 that prizes may be awarded. Such prizes are inherently promotional. With respect to claim 50, Cannon discloses the provision of a bonus game when a bonus condition is met at column 24, lines 20-25. With respect to claim 51, the bonus indicating games of Cannon operate randomly to indicate whether or not the player is entitled to a bonus.

### ***Response to Arguments***

Applicant's arguments filed on October 3, 2006 have been fully considered but they are not persuasive. The amendments to the claims do not overcome the Cannon reference. While applicant attempts to distinguish between the "bonus indicator" of the present invention and the games of Cannon, there is nothing about a "bonus indicator" which precludes the use of a game to provide such an indication. The "secondary" games of Cannon operate substantially simultaneously with the "primary" game, independent of any outcome of the "primary" game, and indicate whether a player is entitled to a bonus feature. Cannon thus reads on the claim limitations, including those

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newly added. Applicant appears to be essentially trying to argue a negative limitation, in that the bonus indicator of Cannon contains game features which are not present in the present invention. However, setting aside the question of whether a negative limitation provides a basis for patentability, there is nothing in the claims which is not taught by Cannon. The rejections are maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
December 22, 2006

A handwritten signature in black ink, appearing to read "K. Fernstrom", written in a cursive style.

**KURT FERNSTROM  
PRIMARY EXAMINER**